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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,760	10/05/2001	Akihiko Toyoshima	50P4257.03	4600
36738	7590	10/26/2006	EXAMINER	
ROGITZ & ASSOCIATES 750 B STREET SUITE 3120 SAN DIEGO, CA 92101			NGUYEN, STEVEN H D	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 10/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

sf

Office Action Summary	Application No. 09/972,760	Applicant(s) TOYOSHIMA, AKIHIKO	
	Examiner Steven HD Nguyen	Art Unit 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,10,11,13,15,17-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,10,11,13,15,17-19 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/16/06 has been entered.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 11 and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Hanava (USP 5450471).

Regarding claims 1, 11 and 17, Hanawa discloses a method and system for providing a multiple format wireless phone (Figs 6-7, 10, 11 and 15) comprising a wireless phone (Fig 6, Ref 1, Figs 7 and , Ref 11, Fig 11, Ref 730 and Fig 15, Ref 780) having a first wireless communication format (Analog or digital, first or second system, Col. 3, lines 9-13) configured to removably receive at least one wireless module (Fig 7, Ref 13, Fig 10, ref 13A, Fig 11, ref 710 and Fig 15, ref 760) having a second wireless communication format (Analog or digital, first or second system, Col. 3, lines 9-13) and said wireless module in electronic data communication

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with the wireless phone (Figs 7, 10-11 and 15, the telephones is coupled via electronic data communication), said wireless module configured to provide the second format to the phone (Analog or digital, first or second system, Col. 3, lines 9-13), wherein the module includes a mobile station identification number, said wireless phone configured to receive said mobile station identification number upon verification of proper operation of the module to facilitate use of a single phone number with both formats (Fig 6, Ref 9 and 10 used to verify the conditions of the portable telephone and transferring the conditions information and subscriber's number etc... to the wireless phone; Fig 6, Ref 1, Figs 7 and , Ref 11, Fig 11, Ref 730 and Fig 15, Ref 780, so that the telephones can be use with the same telephone number, See col. 9, lines 48-50, col. 11, line 55 to col. 12, line 59).

Regarding claim 18, Hanawa discloses operational data comprises at least one wireless format (Analog or digital, first or second system, Col. 3, lines 9-13).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-5, 10, 13, 15, 19 and 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Hanava in view of Metroka (USP 5249302).

Regarding claims 2-3, 13 and 21, Hanawa fails to disclose providing at least one wireless module comprises utilizing at least one wireless format selected from the group consisting of

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CDMA ONE, CDMA 2000 1X, CDMA 2000 3X, CDMA 1X EV, Wideband CDMA, GSM, GPRS and EDGE. In the same field of endeavor, Metroka discloses a multiple mode telephone system herein a wireless module utilizing at least one wireless format selected from the group consisting of CDMA, TDMA "GSM" (Col. 12, lines 19-39).

Since, Hanawa discloses a dual mode telephone system containing two formats such analog and digital. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply CDMA and TDMA format as disclosed by Metroka into the system and method of Hanawa. The motivation would have been to utilize of additional transmission capacity of cellular communication system.

Regarding claims 4-5, 10, 15 and 19, Hanawa fails to disclose providing said wireless module with an electronic serial number for storing to wireless phone. In the same field of endeavor, Metroka discloses providing said wireless module with an electronic serial number for storing to wireless phone (Col. 14, line 62 to col. 15, Line 3 and col. 15, lines 32-38 and col. 17, lines 1-28).

Since, Hanawa discloses a dual mode telephone system containing two formats such analog and digital wherein a wireless module provides a subscriber's number such as ID information to the wireless phone. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method and system for providing the radiotelephone serial number of the wireless module to the wireless telephone as disclosed by Metroka into the system and method of Hanawa. The motivation would have been to utilize of additional transmission capacity of cellular communication system.

Response to Arguments

5. Applicant's arguments filed 8/16/06 have been fully considered but they are not persuasive.
6. The applicant states that Hanava does not disclose storing the mobile station identification number to the wireless phone only upon determination that the wireless module provides proper operation in an intended area to facilitate communication using a common phone number with either format. In reply, Hanava discloses storing the mobile identification number to the wireless phone upon determination that the wireless module provides proper operation in an intended area to facilitate communication using either format such Fig 6, Ref 9 and 10 used to verifying if the wireless module works with intended area by identifying control channel, radio frequency for connection with the base stations with the formats such analog and digital.... Then transferring the identifier number to the wireless telephone in order to allow wireless phone to facility a communication with either format (Fig 6, Fef 1, Figs 7 and., Ref 11, Fig 11, Ref 730 anà Fig 15, Ref 780 and col. 9, lines 48-50 and col. 11, lines 55 to col. 12, lines 24) as stated in claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (571) 272-3159. The examiner can normally be reached on 8:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on (571) 272-3134. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Steven H.D. Nguyen
Primary Examiner
Art Unit 2616
October 24, 2006